

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Andreas Rüther, et al.

Serial No.: 10/511,080

Filed: October 12, 2004

For: METHOD FOR OVERPAINTING
CHROMOPHORE AND/OR EFFECT-
PRODUCING MULTI-LAYER PAINTS

Group Art Unit:
1792

Examiner: Elena Tsoy Lightfoot

Confirmation No.: 7054

I hereby certify that the attached correspondence is being submitted by EFS-Web as an eFiled Response, addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22131-1450, on November 17, 2009.

/AimcePeluyera/
Aimce Peluyera

RESPONSE TO ADVISORY

Mail Stop Amendment After Final
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22131-1450

Dear Sir:

This is in response to the outstanding Advisory Office Action of October 28, 2009, wherein the rejection of pending claims 1-3, 5-8, 12, 14-20, 22, 24, and 25 was maintained. Applicants' comments are submitted with a Notice of Appeal in the hope that they will further communication with the Examiner.

Applicants hereby petition under 37 CFR 1.136 or other applicable rule to have the response period extended 3 months necessary to render the attached communication timely. The Commissioner is hereby authorized to charge to Deposit Account 06-1130 any fees necessary for entry of this amendment and/or extension of time.

The Advisory Action selectively responds to Applicants' factual and legal arguments in Applicants' Amendment of October 19, 2009. For example, with respect to the primary reference (Mayer), the Examiner has responded to one issue addressed on page 8 of Applicants Amendment, but omits mention of Applicants' arguments on pages 9-13 of the same Amendment. Similarly, with respect to Hartung, the Examiner has responded to one issue addressed in the second paragraph of page 14 of Applicants' Amendment of October 19, 2009, but omits mention of the other arguments in that paragraph or, indeed, the arguments in the first and third paragraph of page 14 and the arguments on pages 15-16 of the same Amendment. Finally, the Examiner addresses an argument in the last six lines of page 16, but omits mention of Applicants extensive discussion on pages 17-22 of the same Amendment. Thus, Applicants respectfully submit that the rejection is insufficient to support obviousness of the claimed subject matter as a whole.

In particular, the Advisory Action, on pages 2 and 3, focuses on the issue of whether Mayer teaches a conventional refinish process or a refinish process used in an OEM line. On that issue, the Examiner argues that Applicants argue against their own disclosure, for the reason that the present specification states, in reference to EP 0521 040 B2 (related to Mayer), that a "film-forming coating composition is first applied to the region of the defect in the OEM finish."

Applicants respectfully submit that it is quite clear that the present specification refers to EP 0521 040 B2 as "a process for producing a multicoat refinish in the conventional sense. This process constitutes a significant advance in refinish in the conventional sense." [Emphasis added.] Taken out of context, the phrase "defect in the OEM finish" is ambiguous as to whether the defect is (1) an original defect or (2) a later defect. However, since the former interpretation is clearly inconsistent with the plain meaning of the relevant paragraph taken as a whole, one must apply the latter interpretation. Thus, defects in an OEM finish can be interpreted to include, for example, damage from a traffic accident, and it does not follow that the Applicants have stated, or otherwise implied that the refinish in Mayer occurs in an OEM line, contrary to the clear statements otherwise in the relevant paragraph. Thus, Applicants respectfully submit that the Examiner's arguments on that issue are in clear error.

Furthermore, the Examiner has failed to respond to Applicants' arguments that Mayer involves the use of abrasion to bare metal, the use of a "conventional refinish primer surfacer," and the refinishing temperature of 60°C, all clearly applying to conventional refinish and not refinish in an OEM line, as the Examiner argues in the absence of factual support.

Applicants further submit that, even assuming *arguendo* that Mayer's process was used in an OEM plant, Mayer does not teach the present process, for the reasons stated on pages 9 to 13 of Applicants' Amendment. For the convenience of the Examiner, Applicants will repeat some of the more relevant points of discussion in Applicants' Amendment:

Importantly, Mayer teaches nothing with respect to the original multicoat finish and, therefore, Mayer nowhere mentions electrostatic spray application of the original finish, as required by the present claims. As described in the present application, it was surprisingly found that the multicoat color and/or effect paint systems with which OEM finishes were overcoated no longer exhibited any deleterious shift in shade and/or any deleterious change in optical effect, especially metallic effect, even though the original finish had been produced by means of electrostatic spray application and the refinish was produced by pneumatic spraying.

In fact, Mayer teaches a tapering technique that is used to compensate for the fact that the refinish basecoat is, contrary to the present claims, different from the original basecoat. The tapering involves applying the refinish basecoat so that it "tapers off into the adjacent areas," so that "from the edge of the area of damage outwards the film thickness gradually diminishes to 0 µm." Col. 1, line 65, to col. 2, line 1. This technique is used to compensate for a change in shade, by gradually blending the different refinish paint shade into the original paint shade....In any case, the tapering technique of Mayer, with respect to the refinish basecoat, is the critical to Mayer's use of the "aqueous coating material" that goes under the refinish basecoat. The aqueous coating material can be a clearcoat that is tapered or, in difficult cases, a lightly colored coating material that is not tapered.

It is also important to note that the "extract" used for film (1) in the present OEM refinish is for a different purpose than the "aqueous coating material" of Mayer. Mayer uses the aqueous coating material to correct a problem caused by tapering of the refinish basecoat...Thus, though both Mayer and the present invention relate to preventing shade changes due to altered orientation, it is for altered orientation arising from entirely different causes. In Mayer, the altered orientation is caused by a change in coating thickness (i.e., tapering off), which in turn is necessary because of the lack of relationship between the original and refinish basecoats (i.e., they are substantially different materials), whereas in the present invention the altered orientation is caused by a change from electrostatic to pneumatic spraying (i.e., different spraying techniques). It would have been entirely unobvious that the latter problem in OEM refinish could be solved based on Mayer's solution to a different problem in post-OEM refinish. Moreover, it would be

entirely unobvious and unpredictable that an extract such as presently claimed could solve the problem of shade change due to a change from electrostatic to pneumatic spraying.

Thus, while Mayer specifically mentions that the refinish is very sensitive to spraying characteristics, Mayer does not address compensating for an original electrostatically applied coating, nor does Mayer select coating materials that, without tapering, provide shade matching of a pneumatically applied coating with an electrostatically applied coating. Mayer nowhere suggests how an electrostatically applied coating can be reconciled with a pneumatically applied coating using the same or substantially the same materials. The Examiner has not addressed these issues for whatever reasons.

Mayer says nothing about using a coating composition that is a pigment-free extract of the original finish basecoat. Furthermore, Mayer says nothing about electrostatic spraying of the original basecoat. Mayer says nothing about the use of a particular binder and crosslinking agent, as required by claim 24, in both the original basecoat and the aqueous material. Mayer says nothing about compensating for a change from electrostatic to pneumatic spraying. Mayer says nothing about post-OEM refinish that does not use a primer-surfacer or sanding to bare metal. Finally, the present claims exclude the tapering required by Mayer, which eliminates the asserted grounds of the rejection, as pointed out by the Applicants in the above-quoted portion of Applicants' Amendment.

With respect to Hartung, the Advisory Action argues that it would have been obvious to use the same basecoat and clearcoat in OEM refinish as in the OEM original basecoat and clearcoat. Again, even assuming *arguendo* that this is correct and also assuming *arguendo*, as before, that Mayer's refinish can be used in OEM refinish, this is clearly insufficient to teach the present invention. Thus, the Examiner has not provided insufficient reasons that the presently taught invention, as claimed, is obvious in view of Mayer and Hartung, alone or in combination, even granting *arguendo* the above-mentioned assertions of the Examiner in the Advisory Action. The Examiner has simply not provided sufficient reasons to explain how one of ordinary skill in the art would have arrived at the present process, in the absence of hindsight based on Applicants' own invention. The asserted teachings in the prior art, even disregarding the error in the

Examiner's interpretation of the prior art, as discussed above, fall far short of the presently claimed invention.

Furthermore, with respect to Hartung, the Examiner has not responded, in the Advisory Action, to Applicants' points in the Amendment of October 19, 2009 regarding the following distinguishing facts:

Hartung does not teach or remotely suggest that Mayer's use of an underlying clearcoat should be used, but not the tapering. Both are necessary in Mayer. Hartung says absolutely nothing about the use of a clearcoat extract and makes no mention or suggestion with respect to the tapering technique of Mayer. There is nothing in Hartung that remotely suggests that one of ordinary skill in the art should use the same basecoat and clearcoat for producing both the original finish and repair finish without using a primer-surfacer or sanding to bare metal. There is nothing in Hartung that remotely suggests using electrostatic spraying for the original basecoat and pneumatic spraying for the refinish basecoat. In fact, there is absolutely no teaching of this in either Mayer or Hartung. The mere assertion that OEM refinish, in general, occurs shortly after OEM original finish, falls far short of any such teachings....Moreover, Hartung enforces Mayer's teaching of requiring a "body filler coat" or primer-surfacer, as compared to the present process of applying the extract to the surface of the original finish. Hartung states that "In the finishing of automobile bodies the basecoats are usually applied over the body filler coat." (Col. 6, lines 28-31.) Finally, with respect to present independent claim 24, the polyurethane and specified crosslinker used in the present extract is nowhere taught by Hartung....Moreover, none of the four aqueous coating compositions used in the working examples of Mayer comprise any crosslinking agent at all.

..... Why would Mayer even use the tapered basecoat and underlying coating material if Mayer was merely applying the same/fresh basecoat and topcoat instead of different basecoat materials? Thus, the hindsight modification of Mayer is contrary to the purpose of Mayer's process. The prior art does not teach obtaining the significant advantages of the present invention, including solving the problem associated with the change from electrostatic to pneumatic spraying.

Finally, the Advisory Action states that "the process limitation with respect to electrostatic spray application might lead to allowable subject matter only upon showing objective evidence of unexpected results."

Applicants have conceded that electrostatic spraying of OEM finishes is *per se* known in the art. However, this does not correct any of the above-noted deficiencies of Mayer or Mayer in view of Hartung or the other cited references not mentioned in the Advisory Action. Hence, the

claimed relationship between the pneumatically sprayed refinish and the electrostatically sprayed original finish, in an automotive plant, or Applicants' solution to the resulting problem of paint orientation, is nowhere taught or remotely suggested by any of the cited references. For the above reasons, taken as a whole, it is respectfully submitted that the cited combination fails to provide the requisite motivation for a prima facie case of obviousness.

Furthermore, in light of the prior art, it was surprising and unforeseeable that the object on which the present invention was based could be achieved by means of the refinish process of the present invention. As stated in the original specification, it was indeed surprising that the overcoated OEM refinish of the present invention did not exhibit any deleterious shift in shade and/or any deleterious change in optical effect, especially metallic effect, particularly when the original finish had been produced by means of electrostatic spray application. This meant that, contrary to the opinion of the art, it was indeed surprisingly possible to copy pneumatically the shades and optical effects produced by means of ESTA application.

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing remarks and the more extended remarks in Applicants' Amendment of September 22, 2009 and Applicants' Response of September 22, 2009. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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